

believes that this term is sufficiently ambiguous that it does not teach or enable one of skill in the art how to practice the invention claimed in the instant application. As the Examiner is aware, an anticipatory reference must be clear enough such that those of skill in the art could "take the description of the invention in the printed publication and combine it with his own knowledge of the particular art and from this combination be put in possession of the invention on which a patent is sought." *In re Donohue*, 766 F.2d 531, 533 226 USPQ 619, 621 (Fed. Cir. 1985). The entire disclosure of Bales discusses the use of the devices therein for the treatment of vascular tissue, i.e., coring through a stenotic area to create a lumen of known diameter (col. 12, lines 13-15). Thus, the entire disclosure is concerned with cardiac revascularization through the process of resolving artherosclerotic plaque buildup in a blood vessel. In light of this, it is unclear to what the brief, ambiguous reference to "smooth muscle coring" is referring. However, it is clear that this brief reference does not "put one of skill in the art in possession of the claimed invention", as is required by the Federal Circuit.

Accordingly, applicant requests that the Examiner withdraw this rejection.

In addition to the above comments, applicant points out that independent claim 41 recites that the voltage is sufficient to volumetrically remove tissue at the target site. Bales does not disclose or suggest the volumetric removal of tissue. By contrast, Bales discloses that the plaque is resolved or eroded (see the abstract; col. 3, lines 8-10 and lines 33-35; col. 7, line 2; and col. 8, lines 15-18). Thus, the catheters in the Bales reference are designed to heat the plaque sufficiently to resolve and erode the plaque build-up, allowing the resolved plaque to either be swept downstream by blood in the vessel or pushed downstream as the catheter is advanced or cored through the vessel. In these instances, the voltage is only modifying the plaque such that it can then be mechanically moved to a different location in the blood vessel; the voltage is not sufficient to volumetrically remove the plaque.

Applicant notes that Bales refers to coring or ablative removal of tissue or plaque on col. 10, lines 34 and 35. As the Examiner is undoubtedly aware, the term "ablation" has a variety of different definitions in this art. In this context, Bales is clearly referring to the heating of tissue; not the volumetric removal of tissue. In col. 11, Bales describes the three waveforms used in the invention (a cutting waveform; and two coagulation

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waveforms). The cutting waveform allows the electrode to cut through the plaque and thereby disengage the plaque from the blood vessel wall so that it can be swept downstream by the blood in the vessel. The coagulation waveforms merely heat the plaque to soften it, thereby allowing for a similar result. In both cases, the waveforms are not designed to volumetrically remove tissue.

In light of the above, applicant believes that claim 41 is allowable over Bales even under the event that the term "smooth muscle coring" has some sort of meaning that is understandable to those of skill in the art.

Applicant has amended independent claim 67 to further recite that the voltage is sufficient to promote revascularization of myocardial tissue in a region of the target site by inducing the generation of new blood vessels in the region of the target site. Bales does not disclose or suggest this step. For this additional reason, applicant requests that these rejections be withdrawn.

Finally, claims 41-87 stand rejected for double patenting over U.S. Patent No. 5,873,855. Although applicant disagrees with this rejection, a terminal disclaimer has been filed concurrently with this response to obviate this rejection.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (408) 736-0224.

Respectfully submitted,


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